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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,855	05/10/2001	Raymond A. Berard	14060/198355(IRC289)	5678

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EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/852,855	BERARD, RAYMOND A.	
	Examiner	Art Unit	
	Tae H. Yoon	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Note that the application was reassigned to the current examiner as pointed out in the last office action, and the current examiner should not be responsible for the action of the former examiner.

A proper terminal disclaimer is acknowledged.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 12, 13, 15, 16 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This New Matter rejection is maintained for reason of record with following response.

Again, one must read the context, and the recited temperatures below 160°C on said page 5 is related to the proceeding sentence, [T] pressure vessel is heated to a temperature of about 130°C to about 155°C, more particularly to about 145°C, ---. Thus said temperature below 160°C means the temperature of about 130°C to about 155°C, not below 155°C. The teaching on page 6, lines 27-28 is related to the teaching on page 5 also. The recited "below 155°C" encompasses 0°C, for example, and there is no evidence or showing that said 0°C would work.

With respect to the cited case laws, case law itself is dependent on the merit of each case, and the examiner does not have to apply said case laws to instant invention. Also, the examiner believes that the particle size of Wertheim is less critical than the instant temperature and duration of time.

The recited dissolution times of 45 minutes or less, 37 minutes or less, 23 minutes or less and 15 minutes or less do not have support either since said dissolution times of 45 minutes or less encompasses 3 minutes for example. The recited 45, 37, 23 and 15 minutes have support. The recited "dissolution time of 45 minutes or less" encompasses 1 minute, for example, and there is no evidence or showing that said 1 minute would work.

With respect to claims 18-20, the recited "37 minutes or less" encompasses 1 minute, for example, and there is no evidence or showing that said 1 minute would work.

With respect to claim 21, the recited "45 minutes or less" encompasses 1 minute, for example, and there is no evidence or showing that said 1 minute would work.

Claims 1-13 and 15-21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the dissolution temperature of 45, 37, 23 and 15 minutes, does not reasonably provide enablement for the dissolution temperature of 45, 37, 23 and 15 minutes or less. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

This rejection is maintained for reason of record with above response.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited temperature of "about 155°C" improperly broadens the scope of claim 1 wherein below 155°C is recited since said about 155°C encompasses 155.2°C for example.

Applicant failed to rebut the rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 and 15-21 are rejected under 35 U.S.C. 103(a) as obvious over Yang et al (US 6,036,726).

Note that anticipation rejection is withdrawn.

Rejection is maintained for reason record with following response.

The temperature, pressure and dissolution time taught by Yang et al encompass and/or overlap the instant temperature, pressure and dissolution time. And thus, any

modification of said temperature, pressure and dissolution time (it automatically depends on said temperature and pressure) in Yang et al would be a *prima facie* obviousness, and applicant failed to show otherwise.

It is a basic physical chemistry that a polymer would dissolve faster and at lower temperature with increased pressure in a closed vessel, and applicant failed to show otherwise.

With respect to the pressure head yields a pressure higher than the equilibrium vapor pressure of a solvent in claim 13, the examiner has stated that Yang et al teach employing a pressure vessel in order to get an elevated pressure, and thus a pressure vessel having a pressure head is an obvious modification, and choosing a temperature and dissolution time within the range disclosed by Yang et al is a *prima facie* obviousness absent showing otherwise contrary to applicant's assertion. Applicant asserts that the use of a pressure head in Yang et al would not be obvious and that the contact time of the solvent and the nylon is not dictated by the location of the pressure head, but by the flow rate of the solvent. Said statement by applicant, the contact time of the solvent and the nylon is not dictated by the location of the pressure, but by the flow rate of the solvent, alone shows no criticality of the location of the pressure head. Note that there is at least one position for the pressure head on the pressure vessel, and any pressure head of the pressure vessel taught by Yang et al would at least in part meet the claim 13 since Yang et al teach the pressure (250 psi) taught by the invention.

With respect to the dissolution time of claims 18-20, it would be obvious results since said dissolution time is dependent on the temperature and pressure used and

since the temperature and pressure taught by Yang et al encompass and/or overlap the instant temperature and pressure.

Applicant asserts that the "pressure vessel" does not indicate that high pressure is necessarily being used in the process, but such assertion has no probative value since Yang et al teach a pressure of 250 psi, and said 250 psi indicates the high pressure process.

Applicant asserts that the example (pressure cooker in kitchen) given by examiner has nothing to do with dissolution of nylon form carper fibers since proteins denature faster at higher temperatures, but the examiner disagrees with such assertion since rice and vegetables do not contain proteins contrary to applicant's assertion.

With respect to applicant's argument based on the data of the declaration, the pressure, 425-460 psig used in the test is broader than the actual invention, and thus it has little probative value. Note that the minimum pressure is recited in claims is about 250 psig, not 425-460 psig used in the test. Also, the temperature of 113°C is not disclosed in the specification, and the page 5 teaches "about 130°C to about 155°C" as discussed above.

The recited temperature, pressure and dissolution of new claim 21 are encompassed and/or overlapped those of Yang et al, and thus they are obvious as discussed above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tae H Yoon
Primary Examiner
Art Unit 1714

THY/August 21, 2006